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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,094	01/23/2004	Jeannie Holmes	022265.0131PTUS (018220.0)	8557
7590 IP Department Patton Boggs, LLP 2001 Ross Avenue Suite 3000 Dallas, TX 75201		02/02/2007	EXAMINER NUTTER, NATHAN M	
			ART UNIT 1711	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/764,094

Applicant(s)

HOLMES ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 19-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 28-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11-06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

In response to the arguments filed 7 April 2006, the following is being placed in effect.

The rejection of claims 1, 2, 4, 5, 10, 11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Oka et al (WO 03/020817), is hereby expressly withdrawn.

The rejection of claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya et al (US 5,981,610), is hereby expressly withdrawn.

The rejection of claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya (US 6,506,331), is hereby expressly withdrawn.

The objection to the disclosure because of the informalities that the term *ethynyl cyclohexanol* throughout the Specification and claims is misspelled, is hereby expressly withdrawn.

### ***Claim Interpretations***

The recitations in the broad claims embrace constituents known to be employed together in various combinations. The recitations of the several ingredients of the formulations of the dependent claims 7-9 and 16-18, due to the number of required constituents, necessarily would not be found within the confines of a single reference. At paragraph [0025], the Specification discloses the "toasted oak dust" as "sometimes used by wineries to enhance the flavor of wine," and that "(w)hen added to the silicone-based compound...gives the resulting product a mottled, speckled, or non-uniform

Art Unit: 1711

appearance that closely resembles natural cork." Since the "toasted oak dust" is disclosed as being for appearance, it will be viewed as a filler chosen for this aspect. Further, the Specification discloses at paragraph [0025] that "*untoasted* oak dust could also be used to obtain *similar results* (emphasis added)." The employment of the pigment is disclosed for aesthetic coloration. The employment of ethynyl cyclohexanol as a platinum catalyst inhibitor (as a regulator) in the silicone resin composition is disclosed at paragraph [0027]. The employment of silicon hydride is disclosed as being "added to insure that the catalyzing reaction works properly," is assumed to be regarded that it is employed as a platinum catalyst coordinating compound, as is known in the prior art.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-45 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The concept of "oak dust that does not consist of natural cork" which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The recitation finds no support in the Specification, as filed. Applicants cannot rely on the Declaration of Tiberia to provide

Art Unit: 1711

support or assumed from applicants' arguments. The concept finds no support in the Specification, as originally filed.

Further, Applicants have not established that cork, is not oak or that "ground cork" differs in any regard to "oak dust." Applicants may be their own lexicographer if the terms are not defined in derogation of their known meanings. Note MPEP 2173.05(a) III, where it states "a patentee or applicant may use terms in a manner" contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly defines the terms." This has not been done. Applicants assert that the statement "(o)ak dust sometimes used to enhance the flavor of wine" is a definition because of the use of the word "is." This runs counter to accepted meanings for definitions since it attempts to equate "oak dust" with its usage as opposed to what it comprises. The Declaration to Tiberia is not deemed relevant, and fails to define the oak over the cork of the references, since cork is an oak.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) or Merguriya (US 6,506,331),

Art Unit: 1711

each as applied to claims rejected above, and further in view of Descamps et al (US 5,162,397), Strauss (US 4,031,059) and Snogren (US 3,296,153) all taken together.

The reference to Oka et al (WO 03/020817) teaches the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Paragraphs [008] through [0010] show the resin (including claims 2 and 11). The fumed silica is included at paragraph [0011]. The use of cross-linking agents include an organic peroxide (claims 5 and 14) at paragraph [0013] and chloroplatanic acid (claims 4 and 13) at paragraph [0017]. Those citations teach the amounts claimed for each compositional limitation, as embraced by the reference.

The patent to Merguriya et al (US 5,981,610) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (lines 19 et seq.) for the resin. Note the paragraph bridging column 3 to column 4 for the use of fumed silica as a known thixotropic agent. Note column 4 (lines 17-22) for the use of chloroplatanic acid, as recited in claim 4. The use of a hollow filler is shown at column 4 (lines 27-48). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

The patent to Merguriya (US 6,506,331) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as

Art Unit: 1711

contemplated and herein claimed. Note column 2 (line 51) to column 3 (line 34) for the resin. Note column 5 (lines 1-16) for the use of fumed silica as a filler. Note column 4 (lines 34-52) for the use of chloroplatanic acid, as recited in claim 4, and (lines 53-64) for the peroxide component. The use of a hollow filler is shown at column 5 (lines 17-64). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

The references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) each show the broad composition of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed.

The reference to Oka et al (WO 03/020817) also teaches the use of the pigments at paragraph [0027] and 1-ethynyl-cyclohexanol, used as a curing inhibitor, at paragraph [0028] as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya et al (US 5,981,610) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 5, bridging column 8 to column 9. At column 5 (lines 1-16) the reference teaches the use of carbon black, zinc white, known colorants. Both features as recited in instant claims 8, 9, 17 and 18

The reference to Merguriya (US 6,506,331) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 1, column 7, and the use of carbon black and zinc white at column 5 (lines 1-16).

The reference to Descamps et al (US 5,162,397) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 2 (lines 30 et seq.), a cross-linking agent of chloroplatanic acid at column 10 (lines 9 and 10) with a silica filler at column 7 (lines 9-16) and a microsphere agent, including the borosilicates of claims 3, 7-9, 12 and 16-18. Note column 1 (lines 50-66) and column 10 (lines 15-24 and 43-63) for the borosilicates and their compositional limitations. The reference teaches the conventionality of using a platinum catalyst inhibitor, such as an acetylenic alcohol (ethynyl cyclohexanol is one) at column 4 (lines 1-25). Carbon black may be included at column 7 (lines 8-16).

The reference to Strauss (US 4,031,059) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 13 (line 31) to column 14 (line 12), with hollow microspheres at column 14 (lines 36 et seq.), a curing agent and a silica filler. Note the Examples. The reference teaches the inclusion of ground cork at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26). The reference is clear as to why ground cork, microspheres and other low density fillers are employed, and deemed essentially equivalent, at column 2 (lines 11-20) and column 4 (lines 59 et seq.) as having a "lower thermal conductivity and higher specific heat."

The reference to Snogren (US 3,296,153) teaches the manufacture of a resin filled composition that may comprise a polysiloxane with a curing agent. The reference further teaches at column 7 (lines 23-66) and Table III, the use of "granulated cork, charred granulated cork" and "small hollow micro spheres," which may be glass or



Art Unit: 1711

ceramic materials and may comprise the borosilicates of the instant claims and silica as suitable filler materials. Note the many Examples.

The primary references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) all show the broad composition as conventional to include a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. The secondary references are relied upon to show the conventionality of each of the various constituents recited in claims 3, 6-9, 12 and 16-18, including the borosilicate microspheres, the toasted oak dust ("charred granulated cork"), pigment, silicon hydride and ethynyl cyclohexanol in silicone resins, including those recited and claimed herein. Since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success. The manipulation of the compositional limitations, depending on availability of materials, anticipated physical characteristics and cost procedures for the manufacture would clearly be within the purview of an artisan skilled in this art. The primary references teach such levels of inclusion. As such, the instant claims would have been obvious to a practitioner in the art in view of the references cited, absent any showing of unexpected results.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

Art Unit: 1711

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren (US 3,296,153) and Oka et al (WO 03/020817), both cited and for the reasons set out above.

The patent application to Akbar et al (SN 10/685,052) teaches essentially the identical composition, except fails to show a filler of fumed silica or microcapsules, or the addition of oak dust. These features are shown to be conventional by Snogren (US 3,296,153) and Oka et al (WO 03/020817) and would have been known at the time the Akbar invention was made.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's arguments filed 7 April 2006 have been fully considered but they are not persuasive.

Regarding the Interview of 9 March 2006, it has not been established that the references cited do not "contain mention of oak dust," as alleged. The references to both Strauss and Snodgren show "charred oak dust" as a suitable filler material in composites of the type herein claimed. Applicants have not shown satisfactorily "that 'oak dust' as defined in the specification is the oak dust associated with the wine-making industry, which necessarily excludes dust made from natural cork." The Declarations do not address any issue regarding the inclusion of the oak dust in compositions as recited herein. The Declaration to Holmes is not relevant since it is drawn to speculation made by observers as "most people that view these stoppers believe the stoppers more closely resemble natural cork stoppers than other synthetic stoppers currently in use," is tantamount to hearsay evidence, and has no basis in science. Further, the Declaration to Tiberia is, likewise, irrelevant since it does not address issues related to the instant claims regarding patentability. The Declaration expounds known facts about cork, but do not show, teach, explain or elucidate why the cork would be excluded. A term is interpreted for its breadth, not in derogation of its known meaning, as herein attempted. Nothing is recited in the claims to exclude the cork employed by either Strauss or Snodgren. Further, it is not clear to this Examiner why applicants insist that the use of oak dust in the composition claimed would present effects any more or less deleterious to the wine bottled with cork over the conventional cork stopper. Applicants may define terms as their own lexicographers, but the term cannot be defined in derogation of its known and accepted meaning, as attempted herein. Oak is oak regardless of how applicants choose to limit their definition.

With regard to the rejection of the claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Oka et al, Merguriya et al ('610) or Merguriya ('331), and further in view of Descamps et al, Strauss and Snogren, all of these references are drawn to composites, just as herein claimed. Applicants are reminded that the rejection was made under 35 USC 103 and not under 35 USC 102. The instant claims are drawn to a composition, not to an object or article, as argued. The references do not have to recognize each and every feature that applicants prefer, desire or even show in their composition. The inclusion of such would infer the characteristics of each component to the mixture. Applicants argue the rejection was made using non-analogous art, as though each reference must teach the use of their composites, and that such use include a bottle stopper. The claims are drawn to filled silicone polymers. The references each show aspects that are included. The references are each drawn to silicone compositions, variously filled with the constituents herein claimed. Again, the rejection is made under 35 USC 103, not under 35 USC 102, as argued.

Regarding the rejection under the judicially-created doctrine of obviousness-type double patenting, no timely filed Terminal Disclaimer has been received. The reference to Snodgren shows the inclusion of the oak dust.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

Art Unit: 1711

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that "(t)he Strauss and Snodgren references are not analogous art.", it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are drawn to compositions of polysiloxane resins with fillers, as herein claimed. Applicants assert these references to be non-analogous since they are not "aimed at providing a substitute for natural cork" and "they reasonably pertinent to the particular problem with which the Applicant was concerned (i.e. providing a substitute for natural cork)." The references do not have to be "aimed at providing a substitute for natural cork" to be analogous since the instant claims are drawn to compositions, per se, not a method of "providing a substitute for cork." Nothing in the claims differentiates over the references, as applied in the rejection under 35 USC 103.

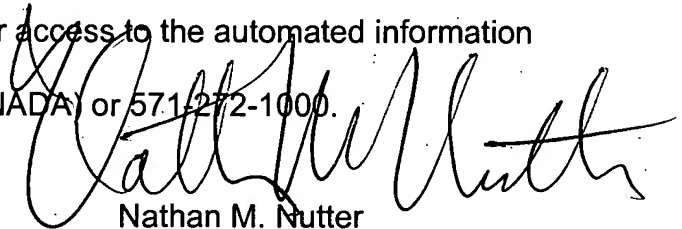
Due to the new grounds of rejection, this action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

26 January 2007